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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,544	10/06/2000	George Yen	BHT/3092/149	8529

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Dougherty & Troxell
5205 Leesburg Pike Suite 1404
Falls Church, VA 22041

EXAMINER

VO, TIM T

ART UNIT

PAPER NUMBER

2189

DATE MAILED: 02/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/679,544

Applicant(s)

YEN, GEORGE

Examiner

Tim T. Vo

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-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefore ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

A timely filed terminal disclaimer in compliance with 37 CFR 1.32(b) and may be used to overcome an actual or provisional rejection based on obviousness-type double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See CFR 1.78(d).

2. Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,378,015. The presently claim limitations have common features disclosed in the

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patented as disclosed for claims 1-4 in different combinations i.e. a disk module of solid state comprising, an IDE interface, a flash memory controller, a power source except wherein the current application does not disclose that the disk module of solid state comprising a flash memory array. It would have been obvious to a person of an ordinary skill in the art at the time the invention was made to implement memory arrays because the memory arrays would increase memory capacity.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application that matured into a patent.

Part III DETAILED ACTION

Notice to Applicant(s)

This application has been examined. Claims 1-11 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pruett et al. patent number 6,263,440 referred hereinafter "Pruett" in view of Lam et al. patent number 5,545,583 referred hereinafter "Lam".

As for claims 1 and 5-7, Pruett teaches a disk module of solid state, comprising:

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a IDE interface (see figure 3, element 52 and column 5 lines 24-33), being a connector to engage with the main board of a computer (see figure 3, wherein the IDE interface is connected to the PCI bus in the mother board of the computer);

a flash memory controller (see figure 3, element 52 and column 5 lines 25-48, wherein the chipset 52 also controls the nonvolatile CMOS RAM (NVRAM) and flash memory 66), being used to control data access and specify an address of data storage (see column 5 lines 24-61, the chipset 52 utilizes DMA to control data transfer);

a power source, being connected to the flash memory controller supply a working voltage (see figure 2, power supply 17 and column 4 lines 42-43);

Pruett does not expressly teach memory array. However, Lam teaches memory array (see column 2 lines 17-21). Therefore, it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to have combined the teachings of Lam into the teachings of Pruett because Lam's memory arrays are densely packed which provides greater storage capacity and limiting space (see column 2 lines 17-21).

As for claims 2-4, Pruett teaches flash memory controller is a single chip controller (see figure 2, chipset 52 and column 5 lines 24-41).

As for claim 8, Pruett teaches the power source extends a power output (see figure 1, power source 17 and column 4 lines 42-60).

As for claims 9-12, Pruett teaches IDE interface is disposed to perpendicular to the casing for a horizontal engagement (see figures 2-3, CD-ROM 30, hard disk 31, chipset 52 which containing IDE interface and column 4 line 24 to column 5 line 32).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim T. Vo whose telephone number is 703-308-5862. The examiner can normally be reached on 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on 703-305-4815. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2100.



Tim T. Vo
Examiner
Art Unit 2189

T.V
February 6, 2003